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10/603,768	06/26/2003	Charlene Myer	87345.1880	4071

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,768

Applicant(s)

MYER ET AL.

Examiner

Shian T Luong

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 20) ☐ Other:

Art Unit: 3728

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a storage unit, classified in class 206, subclass 373.
 - II. Claims 23-27, drawn to a method, classified in class 53, subclass unknown.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as placing the tray on the hood of a car or underneath the car.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with applicant's attorney on 4/15/05, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

Art Unit: 3728

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 is incomplete and indefinite. Applicant has not recited any structural feature but the lid is sized. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,8,9,11,12,13,14,15,18,20,21,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 5,788,072) in view of Wright (US 5,678,684). Chen discloses a base 10, a tray 30 configured to sit within the base and be removable from the base. The tray has a handle and a plurality of cavities to provide storage areas for items in a press fit manner depending upon the item. A storage area is situated between the tray and the base when the tray is seated in the base. A lid configured to be pivotally attached to the base and is removable therefrom by removing the hinge. The lid configured to enclose the tray between the base and the lid when the lid is in a closed position. A pair of latches with closing buckle is mounted on the lid

Chen does not disclose the height of the tray and the base. However, one of ordinary skill in the art would determine the desired dimension of the container prior to submitting the print to manufacturing. For example, Wright teaches a container 120 with a height of about 2 inches.

The container has an insert therein. Hence, it would have been obvious in view of Wright to determine the desired dimension for the container and the insert through routine experiments.

With respect to claim 8, it would have been obvious to determine the size of the base by experimenting with different dimension to store the predetermined articles therein.

With respect to claim 9, it would have been obvious to mount the handle on the handle since it would work equally well.

With respect to claim 12, it would have been obvious to determine the size of the base and tray height by experimenting with different dimension to store the predetermined articles therein.

The tray would fit into the lid because the tray has a smaller dimension in width in comparison to the aperture in the lid as shown in Figure 3. Also, the aperture in the base to receive the tray is the same dimension as the aperture in the lid.

8. Claims 2 and 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Huang (US 6,260,700). Chen discloses generally all of the limitations of the claims, but does not show a hole extending through the tray. But Huang teaches an insert with apertures 20 that extending through the tray. It would have been obvious in view of Huang to provide an opening in the tray to either receive a drawer or to hold a part that extends through the tray.

9. Claims 3-7, 12, 17,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Official Notice. Chen fails to show a door pivotally attached to the tray to pivot between an open and closed position and a removable container therein. However, the placement of a door on a tray is notoriously known

Art Unit: 3728

in the art to provide a lid for a storage compartment. It would therefore have been obvious in view of Official Notice to provide a lid on the tray to secure the storage compartment. It would also have been obvious to make the container transparent to allow viewing purpose.

With regard to the list on the tray, it is also well known to provide indicia on the container or lid to indicate the content.

With respect to claims 12 and 21, it would have been obvious to determine the size of the base and tray height by experimenting with different dimension to store the predetermined articles therein.

10. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Dickinson et al. (Des. 385,111). Chen as modified above discloses all of the elements of the claims, but does not show a handle on the tray. However, Dickinson et al. shows a handle on the tray for ease of transportation. It would have been obvious in view of Dickinson et al. to provide a handle on the tray for moving the tray in and out of the container.

Conclusion

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. If in receiving this Office Action it is

Art Unit: 3728

apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370. For applicant's convenience, the official FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL

May 20, 2005

Primary Examiner


Shian Luong

Art Unit 3728